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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,738

03/30/2005

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EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,738	Applicant(s) MIZUNO ET AL.	
	Examiner Robert Sellers	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 11-49 and 56-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 and 50-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1796

1. Claims 1-9, 11-16, 18-30, 32-43, 45-49, 56-59, 66-69, 76-79 and 81-86 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to inventions non-elected without traverse in the response filed November 13, 2007, there being no allowable generic or linking claim. Claims 17, 31, 44, 60-65, 70-75 and 80 are withdrawn as directed to non-elected species of phenol-modified (claims 17 and 60-65) or epoxy/phenol-modified (claims 31 and 70-75) cyanate ester oligomer with a polyphenylene ether, or epoxy/phenol-modified cyanate ester oligomer reacted in the presence of a polypyphenylene ether (claims 44 and 80).

2. New claim 85 is directed to a phenol-modified cyanate ester oligomer derived from the reaction of a cyanate ester and a monovalent phenol in the presence of a polyphenylene ether. New claim 86 is drawn to the composition further comprising a second composition of the phenol-modified cyanate ester oligomer. These claims are equivalent to claim 43 of the non-elected invention of Group X set forth in the restriction and election of species requirement mailed October 11, 2007 (page 3, lines 7-8) and are hereby withdrawn.

3. The suggestions for more concise language regarding withdrawn claim 17 in the non-Final rejection on page 2, paragraph 1 as well as claims 51, 53, 61, 63, 71 and 73 on page 3, paragraph 2 have been adopted in the amendment filed April 10, 2008.

4. The certified English translation for Japanese priority application no. 2002-287071 establishes a foreign priority date of September 30, 2002 which antedates the effective filing date of March 5, 2003 for Takai et al. Publication No. 2005/0121229 and the publication date of October 23, 2002 for Japanese Patent No. 2002-309085. (Japanese '085). Consequently, the 35 U.S.C. 103(a) rejections over Takai et al. and Sugio Patent No. 4,496,695 in view of Davis et al. Patent No. 7,022,777 and Japanese '085, as well as over Japanese Patent No. 2000-336188 and Sase et al. Patent No. 6,156,831 in view of Japanese Patent No. 2002-309085 are withdrawn. There is no motivation to add the particular species of biphenyl epoxy resin to the compositions of Sugio et al., Japanese Patent No. 2000-336188 and Sase et al. since the basis for the motivation embodied in Japanese '085 has been antedated.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection.

Claims 10 and 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. Patent No. 7,157,506.

5. Although Japanese '085 has been antedated, Mizuno et al. clearly identifies the claimed biphenyl epoxy resin in column 16, line 63 as epoxy resin (H) (col. 15, lines 40-43). It would have been obvious to incorporate an epoxy resin (H) such as the biphenyl epoxy resin in order to optimize the dielectric properties and heat resistance.